

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Thomas L. CANTOR et al.

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

Confirmation No.: 4476

**RENEWED PETITIONS TO EXPUNGE INFORMATION  
UNDER 37 C.F.R. § 1.59 (b)**

MS Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

**First Petition**

Pursuant to 37 C.F.R. § 1.59(b) and MPEP § 724, Applicants hereby re-petition the Commissioner to have the 8 documents expunged from the file that were submitted in the above-identified application with the Supplemental Information Disclosure Statement filed under MPEP § 724.02 on December 6, 2007. A Petition to Expunge Information was also filed with the Supplemental Information Disclosure Statement on December 6, 2007. To date, Applicants have not received a decision on the Petition submitted on December 6, 2007. Applicants attach a copy of the originally filed documents as Exhibit A. Applicants note that the required fee set forth in 37 CFR § 1.17(g) was submitted with the Petition, and, accordingly, believe no further fee is required.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for document numbers 1-8 listed on the attached Form PTO/SB/08a/b from December 6, 2007 because they are **SUBJECT TO PROTECTIVE ORDER**. Document numbers 1-8 are from *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, from the U.S.D.C. for the Central District of California, Case No. CV04-08871 MRP (MANx), appealed as Case No. 2008-1522 at the United States Court of Appeals for the Federal Circuit. These documents have not otherwise been made public.

Applicants acknowledge that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER** (document numbers 1-8 on the attached Form PTO/SB/08a/b), Applicants will preserve the documents for the entire term of the patent in accordance with MPEP § 724.05 (C). Please return the documents to the undersigned.

Pursuant to MPEP § 725.05 (D), Applicants hereby state that this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

### **Second Petition**

Pursuant to 37 C.F.R. § 1.59(b) and MPEP § 724, Applicants also hereby re-petition the Commissioner to have the 5 documents submitted in the above-identified application with the Supplemental Information Disclosure Statement filed under MPEP § 724.02 on August 5, 2005 expunged.

A Petition Decision dated October 6, 2005 “Dismissed” the Petition to Expunge Information originally submitted with the Supplemental Information Disclosure Statement on August 5, 2005. The October 6, 2005 Petition Decision instructed the Applicants to resubmit the Petition to Expunge Information subsequent to a Notice of Allowability. A Notice of Allowability was mailed on March 23, 2009 and the Issue Fee was paid on June 19, 2009. The Petition Decision also states that no additional petition fee will be required at that time. Accordingly, no fees are

included with this resubmitted Petition to Expunge Information. Applicants attach a copy of the originally submitted documents and Petition Decision as Exhibit B.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for document numbers 1-5 listed on the attached Form PTO/SB/08a/b from August 5, 2005 because they are **SUBJECT TO PROTECTIVE ORDER**. Document numbers 1-5 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, case number 02 CV 0046 B (JMA), appealed at the United States Court of Appeals for the Federal Circuit as case numbers 06-1087 and 06-1443. These documents have not otherwise been made public.

Applicants acknowledge that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER** (document numbers 1-5 on the attached Form PTO/SB/08a/b), Applicants will preserve the documents for the entire term of the patent in accordance with MPEP § 724.05 (C). Please return the documents to the undersigned.

Pursuant to MPEP § 725.05 (D), Applicants hereby state that this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

### **Third Petition**

Pursuant to 37 C.F.R. § 1.59(b) and MPEP § 724, Applicants also hereby re-petition the Commissioner to have the 28 documents submitted in the above-identified application with the Supplemental Information Disclosure Statement filed under MPEP § 724.02 on May 3, 2006 expunged.

A Petition Decision dated July 21, 2006 “Dismissed” the Petition to Expunge Information originally submitted with the Supplemental Information Disclosure Statement on May 3, 2006. The July 21, 2006 Petition Decision instructed the Applicants to resubmit the Petition to Expunge Information subsequent to a Notice of Allowability. A Notice of Allowability was mailed on March 23, 2009 and the Issue Fee was paid on June 19, 2009. The Petition Decision also states

that no additional petition fee will be required at that time. Accordingly, no fees are included with this resubmitted Petition to Expunge Information. Applicants attach a copy of the originally submitted documents and Petition Decision as Exhibit C.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for document numbers 1-28 listed on the attached Form PTO/SB/08a/b from May 3, 2006 because they are **SUBJECT TO PROTECTIVE ORDER**. Document numbers 1-27 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, case number 02 CV 0046 B (JMA), appealed at the United States Court of Appeals for the Federal Circuit as case numbers 06-1087 and 06-1443. Document number 28 is from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, from the U.S.D.C. for the Central District of California, Case No. CV04-08871 MRP (MANx), appealed as Case No. 2008-1522 at the United States Court of Appeals for the Federal Circuit. All 28 of these documents have not otherwise been made public.

Applicants acknowledge that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER** (document numbers 1-28 on the attached Form PTO/SB/08a/b), Applicants will preserve the documents for the entire term of the patent in accordance with MPEP § 724.05 (C). Please return the documents to the undersigned.

Pursuant to MPEP § 725.05 (D), Applicants hereby state that this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

#### **Fourth Petition**

Pursuant to 37 C.F.R. § 1.59(b) and MPEP § 724, Applicants also hereby re-petition the Commissioner to have the 2 documents submitted in the above-identified application with the Supplemental Information Disclosure Statement filed under MPEP § 724.02 on February 1, 2008 expunged.

A Petition Decision dated February 8, 2008 “Dismissed” the Petition to Expunge Information originally submitted with the Supplemental Information Disclosure Statement on February 1, 2008. The February 8, 2008 Petition Decision instructed the Applicants to resubmit the Petition to Expunge Information subsequent to a Notice of Allowability. A Notice of Allowability was mailed on March 23, 2009 and the Issue Fee was paid on June 19, 2009. The Petition Decision also states that no additional petition fee will be required at that time. Accordingly, no fees are included with this resubmitted Petition to Expunge Information. Applicants attach a copy of the originally submitted documents and Petition Decision as Exhibit D.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for document numbers 1-2 listed on the attached Form PTO/SB/08a/b from February 1, 2008 because they are **SUBJECT TO PROTECTIVE ORDER**. Document numbers 1-2 are from *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, from the U.S.D.C. for the Central District of California, Case No. CV04-08871 MRP (MANx), appealed as Case No. 2008-1522 at the United States Court of Appeals for the Federal Circuit. These documents have not otherwise been made public.

Applicants acknowledge that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER** (document numbers 1-2 on the attached Form PTO/SB/08a/b), Applicants will preserve the documents for the entire term of the patent in accordance with MPEP § 724.05 (C). Please return the documents to the undersigned.

Pursuant to MPEP § 725.05 (D), Applicants hereby state that this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **532212000623**.

Dated: August 21, 2009

Respectfully submitted,

By     /Peng Chen/      
Peng Chen  
Registration No.: 43,543  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040  
(858)720-5117

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 781835556 US, on the date shown below in an envelope addressed to: MS Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: December 6, 2007

Signature: *Amate*

(Anthony Matson)



Patent

Docket No. 532212000623

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

**SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENT UNDER MPEP § 724.02**

MS Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the duty of disclosure in 37 C.F.R. § 1.56, Applicants hereby submit under MPEP § 724.02 the documents listed on the attached Form PTO/SB/08a/b. The attention of the Patent and Trademark Office is hereby directed to these documents because they are **SUBJECT TO PROTECTIVE ORDER.**

The documents set forth on the enclosed Form PTO/SB/08a/b have not been submitted or cited in the present application. It is understood that the Office is under no obligation to consider these documents at this time; however, to comply with the Applicants' duty of disclosure and to complete the record, they are submitted. Applicants believe that the documents are in no way destructive of patentability of the allowed claims.

The document numbers 1-8 listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of each document that is **SUBJECT TO PROTECTIVE ORDER** listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope.

Document numbers 1-8 are from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, currently pending in the United States District Court for the Central District of California, Case No. CV 04-08871 MRP (MANx). Scantibodies Laboratory, Inc. is the owner of the present application. This litigation involves U.S. Patent No. 6,689,566. The present application is a Continuation-in-Part of U.S. Patent No. 6,743,590, which is a Continuation-in-Part of U.S. Patent No. 6,689,566.

Note that information designated by Immutopics as "Confidential" or "Confidential-Attorneys' Eyes Only" has been redacted from document numbers 7 and 8 on the attached Form PTO/SB/08a/b. This includes the portion of the Points and Authorities in support of Immutopics' non-infringement motion which references Immutopics' Confidential information. This also includes text in paragraphs 5 and 7 of document number 8, the Declaration of Jeffrey Lavigne, and Exhibit Z referenced in that text (excerpts from the transcript of the deposition of Lavigne).

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.



In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **532212000623**.

Dated: December 6, 2007

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543

MORRISON & FOERSTER LLP

12531 High Bluff Drive, Suite 100

San Diego, California 92130-2040

(858) 720-5117



ALTERNATIVE TO PTO/SB/08A/B (04/07)

|   |                  |    |                          |  |  |
|---|------------------|----|--------------------------|--|--|
| Substituted for USPTO Form 1449/PTO<br><br><b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br><i>(Use as many sheets as necessary)</i> |                  |    | <b>Complete if Known</b> |  |  |
| Application Number  | 10/617,489       |    |                          |  |  |
| Filing Date   | July 10, 2003    |    |                          |  |  |
| First Named Inventor  | Thomas L. CANTOR |    |                          |  |  |
| Art Unit  | 1641             |    |                          |  |  |
| Examiner Name   | C. Cheu          |    |                          |  |  |
| Attorney Docket Number  | 532212000623     |    |                          |  |  |
| Sheet   | 1                | of | 1                        |  |  |

| NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER |                       |   |                |  |
|---|-----------------------|---|----------------|--|
| Examiner Initials*  | Cite No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T <sup>2</sup> |  |
|   | 1.                    | Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment for Failing to Disclose the Best Mode, filed November 13, 2007   |                |  |
|   | 2.                    | Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment for Failing to Disclose the Best Mode, filed November 13, 2007   |                |  |
|   | 3.                    | Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Violation of On Sale Bar and for Obviousness over the Prior Art, filed November 13, 2007                              |                |  |
|   | 4.                    | Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Violation of On Sale Bar and for Obviousness over the Prior Art, filed November 13, 2007                                |                |  |
|   | 5.                    | Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Lack of Enablement, filed November 13, 2007   |                |  |
|   | 6.                    | Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Lack of Enablement, filed November 13, 2007   |                |  |
|   | 7.                    | Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Non-Infringement of the '566 Patent, filed November 13, 2007  |                |  |
|   | 8.                    | Declaration of Jeffrey Lavigne in Support of Defendants' and Counterclaimants' Motion for Summary Judgment Based on Non-Infringement of the '566 Patent, filed November 13, 2007  |                |  |

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a check mark here if English language Translation is attached.

|                    |  |                 |  |
|--------------------|--|-----------------|--|
| Examiner Signature |  | Date Considered |  |
|--------------------|--|-----------------|--|

sd-402389

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 781935656 US, on the date shown below in an envelope addressed to: MS Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: December 6, 2007

Signature:

*Anthony Matson*  
(Anthony Matson)

Patent

Docket No. 532212000623

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Thomas L. CANTOR

Examiner: C. Cheu

Group Art Unit: 1641

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

**PETITION TO EXPUNGE INFORMATION  
UNDER 37 C.F.R. § 1.59 (b)**

MS Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.59(b) and MPEP § 724, Applicants hereby petition the Commissioner to have the 8 documents submitted in the above-identified application with the Supplemental Information Disclosure Statement filed under MPEP § 724.02 on December 5, 2007 expunged upon allowance, issue, or abandonment of this application.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for document numbers 1-8 listed on the attached Form PTO/SB/08a/b because they are **SUBJECT TO PROTECTIVE ORDER**. The documents are from *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, currently pending in the U.S.D.C. for the Central District of California, Case No. CV04-08871 MRP (MANx). All of these documents have not otherwise been made public.

sd-403173



12/11/2007 WBE/ELR1 00000004 031952 10617489  
01 FC:1463 200.00 DA

Applicants acknowledge that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER** (document numbers 1-8 on the attached Form PTO/SB/08a/b), Applicants will preserve the documents for the entire term of the patent in accordance with MPEP § 724.05 (C). Please return the documents to the undersigned upon allowance, issue, or abandonment of this application.

Pursuant to MPEP § 725.05 (D), Applicants hereby state that this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

Pursuant to MPEP § 725.05 (E), the Commissioner is hereby authorized to charge the required fee under 37 C.F.R. § 1.17(g) for a petition under 37 C.F.R. § 1.59(b) to **Deposit Account No. 03-1952** referencing docket no. **532212000623**. Fee Transmittal (form PTO/SB/17p) is attached in duplicate.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **532212000623**.

Dated: December 6, 2007

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040  
(858)720-5117



12-10-07

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Approved for use through 11/30/2007. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

|   |                      |                        |              |
|---|----------------------|------------------------|--------------|
| <b>TRANSMITTAL<br/>FORM</b><br><br>(to be used for all correspondence after initial filing) | Application Number   | 10/617,489             |              |
|   | Filing Date          | July 10, 2003          |              |
|   | First Named Inventor | Thomas L. CANTOR       |              |
|   | Art Unit             | 1641                   |              |
|   | Examiner Name        | C. Cheu                |              |
| Total Number of Pages in This Submission  | 10                   | Attorney Docket Number | 532212000623 |

**ENCLOSURES (Check all that apply)**

|  |  |   |
|--|--|---|
| <input type="checkbox"/> Fee Transmittal Form                                  | <input type="checkbox"/> Drawing(s)  | <input type="checkbox"/> After Allowance Communication to TC                            |
| <input type="checkbox"/> Fee Attached  | <input type="checkbox"/> Licensing-related Papers  | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences     |
| <input type="checkbox"/> Amendment/Reply                                       | <input checked="" type="checkbox"/> Petition - Petition To Expunge Information (2 pages) | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final   | <input type="checkbox"/> Petition to Convert to a Provisional Application                | <input type="checkbox"/> Proprietary Information  |
| <input type="checkbox"/> Affidavits/declaration(s)                             | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  | <input type="checkbox"/> Status Letter  |
| <input type="checkbox"/> Extension of Time Request                             | <input type="checkbox"/> Terminal Disclaimer   | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):         |
| <input type="checkbox"/> Express Abandonment Request                           | <input type="checkbox"/> Request for Refund  | Fee Transmittal - Form PTO/SB/17p (1 page + duplicate for fee processing)               |
| <input checked="" type="checkbox"/> Information Disclosure Statement (3 pages) | <input type="checkbox"/> CD, Number of CD(s) _____                                       | Form PTO/SB/08A/B (1 page + duplicate)  |
| <input type="checkbox"/> Certified Copy of Priority Document(s)                | <input type="checkbox"/> Landscape Table on CD   | 8 References  |
| <input type="checkbox"/> Reply to Missing Parts/Incomplete Application         | Remarks  |   |
| <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53      | Customer No. 25225   |   |

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|              |                         |          |        |
|--------------|-------------------------|----------|--------|
| Firm Name    | MORRISON & FOERSTER LLP |          |        |
| Signature    |                         |          |        |
| Printed name | Peng Chen               |          |        |
| Date         | December 6, 2007        | Reg. No. | 43,543 |

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airmail No. EV 78183656 US, on the date shown below in an envelope addressed to: MS Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: December 6, 2007

Signature: A. Matson (Anthony Matson)



Approved for use through 11/30/2007. OMB 0651-0031  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FEE**  
**Under 37 CFR 1.17(f), (g) & (h)**  
**TRANSMITTAL**

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

|                        |                  |
|------------------------|------------------|
| Application Number     | 10/617,489       |
| Filing Date            | July 10, 2003    |
| First Named Inventor   | Thomas L. CANTOR |
| Art Unit               | 1641             |
| Examiner Name          | C. Cheu          |
| Attorney Docket Number | 53221200623      |

Enclosed is a petition filed under 37 CFR 1.59 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 200.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/5B/171.

**Payment of Fees** (small entity amounts are NOT available for the petition fees).

- ☐ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 03-1952 :  
☒ petition fee under 37 CFR 1.17(f), (g) or (h) ☐ any deficiency of fees and credit of any overpayments  
Enclose a duplicate copy of this form for fee processing.

- ☐ Check in the amount of \$ \_\_\_\_\_ is enclosed.  
☐ Payment by credit card (Form PTO-2036 or equivalent enclosed). Do not provide credit card information on this form.

**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1452**

For petitions filed under:

- § 1.35(a) - for revocation of a power of attorney by fewer than all applicants
- § 1.53(e) - to record a filing date.
- § 1.57(a) - to record a filing date.
- § 1.162 - for decision on a question not specifically provided for.
- § 1.153 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to record a filing date to an application under § 1.740 for extension of a patent term.

**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1453**

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expurgement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 1.658 - for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

**Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

- § 1.19(b) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(a) - to make an application special.
- § 1.136(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

\_\_\_\_\_  
Signature

December 6, 2007

\_\_\_\_\_  
Date

Peng Chen

43,543

Typed or printed name

Registration No., if applicable

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airtel No. EV 781835656 US, on the date shown below in an envelope addressed to: MS Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: December 6, 2007

Signature: Anthony Matson

(Anthony Matson)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airmail No. EL 961005292 US, in a BOX addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date: August 5, 2005

Signature:

(Diane Blevins)

Patent

Docket No. 532212000623



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

### SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER MPEP 724.02

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.56 and MPEP 724.02, the attention of the Patent and Trademark Office is hereby directed to the **SUBJECT TO PROTECTIVE ORDER** documents listed on the attached Form PTO/SB/08a/b. It is respectfully requested that the information be expressly considered during the prosecution of this application.

The document numbers 1-5 listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. These documents are from civil action number 02 CV 0046 B (JMA), *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, currently pending in the United States District Court for the Southern District of California.

A copy of each document that is **SUBJECT TO PROTECTIVE ORDER** listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
  - ☐ A fee is required. A check in the amount of \_\_ is enclosed.
  - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of \_\_ is enclosed.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicant would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.



The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 532212000623.

Dated: August 5, 2005

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543  
MORRISON & FOERSTER LLP  
3811 Valley Centre Drive  
Suite 500  
San Diego, California 92130-2332  
(858) 720-5117



ALTERNATIVE TO PTO/SB06a/b (06-03)

|  |   |                          |   |
|--|---|--------------------------|---|
| Substitute for form 1449/PTO<br><b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><i>(Use as many sheets as necessary)</i> |   | <b>Complete if Known</b> |   |
| Application Number   |   | 10/617,489               |   |
| Filing Date  |   | July 10, 2003            |   |
| First Named Inventor   |   | Thomas L. CANTOR         |   |
| Art Unit   |   | 1641                     |   |
| Examiner Name  |   | C. Cheu                  |   |
| Attorney Docket Number   |   | 532212000623             |   |
| Sheet  | 1 | of                       | 1 |

| NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER |                       |   |                |
|---|-----------------------|---|----------------|
| Examiner Initials   | Cite No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T <sup>2</sup> |
|   | 1.                    | Memorandum of Points and Authorities in Support of Scantibodies' Motion for Summary Judgment of Invalidity and Noninfringement, filed February 18, 2005   |                |
|   | 2.                    | Declaration of Katherine L. Parker in Support of Scantibodies' Motion For Summary Judgment of Invalidity and Noninfringement, with Exhibits 1-39, filed February 18, 2005   |                |
|   | 3.                    | Nichols Institute Diagnostics, Inc.'s Opposition to Motion For Summary Judgment of Invalidity and Non-Infringement, filed March 7, 2005   |                |
|   | 4.                    | Declaration of Julia A. Miller In Support of Nichols Institute Diagnostics, Inc.'s Opposition to Motion For Summary Judgment of Invalidity and Non-Infringement, with Exhibits A-E, filed March 7, 2005   |                |
|   | 5.                    | Declaration of Katherine L. Parker in Support of Scantibodies' Reply Motion For Summary Judgment of Invalidity and Noninfringement, with Exhibits 1-4, filed March 14, 2005   |                |

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a check mark here if English language Translation is attached.

|                    |  |                 |  |
|--------------------|--|-----------------|--|
| Examiner Signature |  | Date Considered |  |
|--------------------|--|-----------------|--|

sd-273642

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, EL 961005292 US, in a BOX addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: August 5, 2005

Signature: 

(Diane Blevins)

Patent

Docket No. 532212000623



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

PETITION TO EXPUNGE INFORMATION  
UNDER MPEP 724.06 AND 37 C.F.R. § 1.59

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Applicant hereby petitions the Commissioner to have the documents submitted with the Supplemental Information Disclosure Statement on August 5, 2005 expunged upon allowance or abandonment of this application in accordance with MPEP 724.06 and 37 CFR § 1.59.

Applicant believes expungement is appropriate for document numbers 1-5 listed on the attached Form PTO/SB/08a/b because they are **SUBJECT TO PROTECTIVE ORDER** in civil action number 02 CV 0046 B (JMA), *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, currently pending in the United States District Court for the Southern District of California.

06/10/2005 SLUAMG1 00000002 031952 10617489

01 FC:1463 200.00 DA

sd-273799

Please return the documents to the undersigned upon allowance or abandonment of this application. Applicant acknowledges that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER** (document Nos. 1-5), Applicant will preserve the documents for the entire term of the patent.

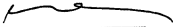
This petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

The Commissioner is hereby authorized to charge the required fee under 37 C.F.R. § 1.17(h) to **Deposit Account No. 03-1952** referencing docket no. 532212000623. Fee Transmittal (form PTO/SB/17p) is attached in duplicate.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 532212000623. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: August 5, 2005

Respectfully submitted,

By   
Peng Chen  
Registration No.: 43,543  
MORRISON & FOERSTER LLP  
3811 Valley Centre Drive  
Suite 500  
San Diego, California 92130-2332  
(858) 720-5117



08-08-05

DAE B JFW

PTO/SB/21 (09-04)  
Approved for use through 07/31/2006, OMB 0651-0031

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

|   |                      |                        |              |
|---|----------------------|------------------------|--------------|
| <b>TRANSMITTAL FORM</b><br><br>(to be used for all correspondence after initial filing) | Application Number   | 10/617,489             |              |
|   | Filing Date          | July 10, 2003          |              |
|   | First Named Inventor | Thomas L. CANTOR       |              |
|   | Art Unit             | 1641                   |              |
|   | Examiner Name        | C. Cheu                |              |
| Total Number of Pages in This Submission  | 11                   | Attorney Docket Number | 532212000623 |

| ENCLOSURES (Check all that apply)   |   |   |
|---|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form (1 page, plus duplicate)             | <input type="checkbox"/> Drawing(s)   | <input type="checkbox"/> After Allowance Communication to TC                            |
| <input type="checkbox"/> Fee Attached   | <input type="checkbox"/> Licensing-related Papers                                       | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences     |
| <input type="checkbox"/> Amendment/Reply  | <input checked="" type="checkbox"/> Petition to Expunge Information (2 pages)           | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final  | <input type="checkbox"/> Petition to Convert to a Provisional Application               | <input type="checkbox"/> Proprietary Information  |
| <input type="checkbox"/> Affidavits/declaration(s)  | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input type="checkbox"/> Status Letter  |
| <input type="checkbox"/> Extension of Time Request  | <input type="checkbox"/> Terminal Disclaimer  | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):         |
| <input type="checkbox"/> Express Abandonment Request  | <input type="checkbox"/> Request for Refund   | PTO/SB/08a/b (1 page)   |
| <input checked="" type="checkbox"/> Information Disclosure Statement (Supplemental - 3 pages) | <input type="checkbox"/> CD, Number of CD(s) _____                                      | Petition Fee Under 37 CFR 1.17(f), (g) & (h) (1 page, plus duplicate)                   |
| <input type="checkbox"/> Certified Copy of Priority Document(s)                               | <input type="checkbox"/> Landscape Table on CD  | 5 references, placed in 5 separate envelopes, appropriately labeled                     |
| <input type="checkbox"/> Reply to Missing Parts/Incomplete Application                        |   | Return Receipt Postcard   |
| <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53                     |   |   |
| Remarks   |   |   |
| CUSTOMER NO. 25225  |   |   |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT |                         |                 |
|--|-------------------------|-----------------|
| Firm Name                                  | MORRISON & FOERSTER LLP |                 |
| Signature                                  |                         |                 |
| Printed name                               | Peng Chen               |                 |
| Date                                       | August 5, 2005          | Reg. No. 43,543 |

|  |                             |
|--|-----------------------------|
| I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail: Airbill No. EL 961005292 US, in a BOX addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below. |                             |
| Dated: August 5, 2005  | Signature:  (Diane Blevins) |

sd-273815



| PETITION FEE<br>Under 37 CFR 1.17(f), (g) & (h)<br>TRANSMITTAL<br>(Fees are subject to annual revision)          |  |                    |            |             |               |                      |                  |          |      |               |         |                        |              |
|--|--|--------------------|------------|-------------|---------------|----------------------|------------------|----------|------|---------------|---------|------------------------|--------------|
| Send completed form to:<br>MS Petition<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 | <table border="1"><tr><td>Application Number</td><td>10/617,489</td></tr><tr><td>Filing Date</td><td>July 10, 2003</td></tr><tr><td>First Named Inventor</td><td>Thomas L. CANTOR</td></tr><tr><td>Art Unit</td><td>1641</td></tr><tr><td>Examiner Name</td><td>C. Cheu</td></tr><tr><td>Attorney Docket Number</td><td>532212000623</td></tr></table> | Application Number | 10/617,489 | Filing Date | July 10, 2003 | First Named Inventor | Thomas L. CANTOR | Art Unit | 1641 | Examiner Name | C. Cheu | Attorney Docket Number | 532212000623 |
| Application Number   | 10/617,489   |                    |            |             |               |                      |                  |          |      |               |         |                        |              |
| Filing Date  | July 10, 2003  |                    |            |             |               |                      |                  |          |      |               |         |                        |              |
| First Named Inventor   | Thomas L. CANTOR   |                    |            |             |               |                      |                  |          |      |               |         |                        |              |
| Art Unit   | 1641   |                    |            |             |               |                      |                  |          |      |               |         |                        |              |
| Examiner Name  | C. Cheu  |                    |            |             |               |                      |                  |          |      |               |         |                        |              |
| Attorney Docket Number   | 532212000623   |                    |            |             |               |                      |                  |          |      |               |         |                        |              |

Enclosed is a petition filed under 37 CFR 1.59 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 200.00 is enclosed.  
This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(f), see form PTO/SB/17f.

Payment of Fees (small entity amounts are NOT available for the petition fees).

- ☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 03-1952 :  
☒ Petition fee under 37 CFR 1.17(f), (g) or (h) ☒ Any deficiency of fees and credit of any overpayments  
Enclose a duplicative copy of this form for fee processing.  
☐ Check in the amount of \$ \_\_\_\_\_ is enclosed.  
☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

- § 1.53(e) – to accord a filing date.
- § 1.57(a) – to accord a filing date.
- § 1.182 – for decision on a question not specifically provided for.
- § 1.183 – to suspend the rules.
- § 1.378(e) – for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) – to accord a filing date to an application under § 1.740 for extension of a patent term.

**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**


For petitions filed under:

- § 1.12 – for access to an assignment record.
- § 1.14 – for access to an application.
- § 1.47 – for filing by other than all the inventors or a person not the inventor.
- § 1.59 – for expungement of information.
- § 1.103(a) – to suspend action in an application.
- § 1.136(b) – for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 – for review of refusal to publish a statutory invention registration.
- § 1.296 – to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 – for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) – for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.955 – for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 – for expedited handling of a foreign filing license.
- § 5.16 – for changing the scope of a license.
- § 5.25 – for retroactive license.

**Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

- § 1.19(g) – to request documents in a form other than that provided in this part.
- § 1.84 – for accepting color drawings or photographs.
- § 1.91 – for entry of a model or exhibit.
- § 1.102(d) – to make an application special.
- § 1.138(c) – to expressly abandon an application to avoid publication.
- § 1.313 – to withdraw an application from issue.
- § 1.314 – to defer issuance of a patent.

  
\_\_\_\_\_  
Signature  
Peng Chen  
\_\_\_\_\_  
Typed or printed name

\_\_\_\_\_  
August 5, 2005  
Date  
43,543  
\_\_\_\_\_  
Registration No., if applicable



|  |      |                          |                     |              |
|--|------|--------------------------|---------------------|--------------|
| Effective on 12/06/2004.<br>Pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). |      | <b>Complete if Known</b> |                     |              |
| <b>FEE TRANSMITTAL</b><br><b>For FY 2005</b>   |      | Application Number       | 10/617,489          |              |
|  |      | Filing Date              | July 10, 2003       |              |
|  |      | First Named Inventor     | Thomas L. CANTOR    |              |
|  |      | Examiner Name            | C. Cheu             |              |
| <input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27      |      | Art Unit                 | 1641                |              |
| TOTAL AMOUNT OF PAYMENT  | (\$) | 180.00                   | Attorney Docket No. | 532212000623 |

|  |  |
|--|--|
| <b>METHOD OF PAYMENT</b> (check all that apply)  |  |
| <input type="checkbox"/> Check <input type="checkbox"/> Credit Card <input type="checkbox"/> Money Order <input type="checkbox"/> None <input type="checkbox"/> Other (please identify): _____ | <input checked="" type="checkbox"/> Deposit Account            Deposit Account Number: <u>03-1952</u> Deposit Account Name: <u>Morrison &amp; Foerster LLP</u> |
| For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)   |  |
| <input checked="" type="checkbox"/> Charge fee(s) indicated below<br><input checked="" type="checkbox"/> Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17     | <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee<br><input checked="" type="checkbox"/> Credit any overpayments               |

|   |                    |  |                    |                     |                         |                     |                                      |                 |  |
|---|--------------------|--|--------------------|---------------------|-------------------------|---------------------|--------------------------------------|-----------------|--|
| <b>FEE CALCULATION</b>  |                    |  |                    |                     |                         |                     |                                      |                 |  |
| <b>1. BASIC FILING, SEARCH, AND EXAMINATION FEES</b>  |                    |  |                    |                     |                         |                     |                                      |                 |  |
|   | <b>FILING FEES</b> |  | <b>SEARCH FEES</b> |                     | <b>EXAMINATION FEES</b> |                     |                                      |                 |  |
|   |                    | <b>Small Entity</b>                                |                    | <b>Small Entity</b> |                         | <b>Small Entity</b> |                                      |                 |  |
| <b>Application Type</b>   | <b>Fee (\$)</b>    | <b>Fee (\$)</b>                                    | <b>Fee (\$)</b>    | <b>Fee (\$)</b>     | <b>Fee (\$)</b>         | <b>Fee (\$)</b>     | <b>Fees Paid (\$)</b>                |                 |  |
| Utility   | 300                | 150  | 500                | 250                 | 200                     | 100                 |                                      |                 |  |
| Design  | 200                | 100  | 100                | 50                  | 130                     | 65                  |                                      |                 |  |
| Plant   | 200                | 100  | 300                | 150                 | 160                     | 80                  |                                      |                 |  |
| Reissue   | 300                | 150  | 500                | 250                 | 600                     | 300                 |                                      |                 |  |
| Provisional   | 200                | 100  | 0                  | 0                   | 0                       | 0                   |                                      |                 |  |
|   |                    |  |                    |                     |                         |                     | <b>Small Entity</b>                  |                 |  |
|   |                    |  |                    |                     |                         |                     | <b>Fee (\$)</b>                      | <b>Fee (\$)</b> |  |
| <b>2. EXCESS CLAIM FEES</b>   |                    |  |                    |                     |                         |                     |                                      |                 |  |
| <b>Fee Description</b>  |                    |  |                    |                     |                         |                     |                                      |                 |  |
| Each claim over 20 (including Reissues)   |                    |  |                    |                     |                         |                     | 50                                   | 25              |  |
| Each independent claim over 3 (including Reissues)  |                    |  |                    |                     |                         |                     | 200                                  | 100             |  |
| Multiple dependent claims   |                    |  |                    |                     |                         |                     | 360                                  | 180             |  |
| <b>Total Claims</b> <b>Extra Claims</b> <b>Fee (\$)</b> <b>Fee Paid (\$)</b>  |                    |  |                    |                     |                         |                     | <b>Multiple Dependent Claims</b>     |                 |  |
| _____ - 20 = _____ x _____ = _____  |                    |  |                    |                     |                         |                     | <b>Fee (\$)</b> <b>Fee Paid (\$)</b> |                 |  |
| <b>Indep. Claims</b> <b>Extra Claims</b> <b>Fee (\$)</b> <b>Fee Paid (\$)</b>   |                    |  |                    |                     |                         |                     |                                      |                 |  |
| _____ - 3 = _____ x _____ = _____   |                    |  |                    |                     |                         |                     |                                      |                 |  |
| <b>3. APPLICATION SIZE FEE</b>  |                    |  |                    |                     |                         |                     |                                      |                 |  |
| If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s). |                    |  |                    |                     |                         |                     |                                      |                 |  |
| <b>Total Sheets</b> <b>Extra Sheets</b> <b>Number of each additional 50 or fraction thereof</b> <b>Fee (\$)</b> <b>Fee Paid (\$)</b>  |                    |  |                    |                     |                         |                     |                                      |                 |  |
| _____ - 100 = _____ / 50  |                    | _____ (round up to a whole number) x _____ = _____ |                    |                     |                         |                     |                                      |                 |  |
| <b>4. OTHER FEE(S)</b>  |                    |  |                    |                     |                         |                     |                                      |                 |  |
| Non-English Specification, \$130 fee (no small entity discount)   |                    |  |                    |                     |                         |                     |                                      |                 |  |
| Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement    180.00   |                    |  |                    |                     |                         |                     |                                      |                 |  |

|   |                  |                                       |  |
|---|------------------|---------------------------------------|--|
| <b>SUBMITTED BY</b>                       |                  | <b>Registration No.</b> <b>43,543</b> | <b>Telephone</b> <b>(858) 720-5117</b> |
| Signature _____                           | (Attorney/Agent) | <b>Date</b> <b>August 5, 2005</b>     |  |
| <b>Name (Print/Type)</b> <b>Peng Chen</b> |                  |                                       |  |

## ARTIFACT SHEET

Enter artifact number below. Artifact number is application number + artifact type code (see list below) + sequential letter (A, B, C...). The first artifact folder for an artifact type receives the letter A, the second B, etc.. Examples: 59123456PA, 59123456PB, 59123456ZA, 59123456ZB

10,617,489 XCB

Indicate quantity of a single type of artifact received but not scanned. Create individual artifact folder/box and artifact number for each Artifact Type.

☐

CD(s) containing:

computer program listing

Doc Code: Computer

pages of specification

and/or sequence listing

and/or table

Doc Code: Artifact

content unspecified or combined

Doc Code: Artifact

☐

Artifact Type Code: P

☐

Artifact Type Code: S

☐

Artifact Type Code: U

☐

Stapled Set(s) Color Documents or B/W Photographs

Doc Code: Artifact

Artifact Type Code: C

☐

Microfilm(s)

Doc Code: Artifact

Artifact Type Code: F

☐

Video tape(s)

Doc Code: Artifact

Artifact Type Code: V

☐

Model(s)

Doc Code: Artifact

Artifact Type Code: M

☐

Bound Document(s)

Doc Code: Artifact

Artifact Type Code: B

☒

Confidential Information Disclosure Statement or Other Documents marked Proprietary, Trade Secrets, Subject to Protective Order, Material Submitted under MPEP 724.02, etc.

Doc Code: Artifact

Artifact Type Code X

☐

Other, description:

Doc Code: Artifact

Artifact Type Code: Z



## UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

OCT - 6 2005

MORRISON & FOERSTER LLP  
3811 VALLEY CENTRE DRIVE  
SUITE 500  
SAN DIEGO CA 92130-2332

In re Application of :  
Thomas L. Cantor et al :  
Serial No.: 10/617,489 : PETITION DECISION  
Filed: July 10, 2003 :  
Attorney Docket No.: 532212000623 :

This is a response to the third petition under 37 CFR 1.59(b), filed August 5, 2005, to expunge additional information from the above identified application.

Petitioner requests that documents submitted August 5, 2005, as Proprietary Information Disclosure Statements be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

This is an examined application and a reply to the last Office action has been filed. The information provided will be reviewed by the examiner in due course. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application petition may be made for return of Proprietary Information Disclosure Statements. This application has not been allowed. Therefore, the information cannot be returned at this time.

The petition is **DISMISSED**. Applicants may resubmit the petition subsequent to a Notice of Allowability or *ex parte* Quayle action being mailed in the application. No additional petition fee will be required at that time.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at general Office facsimile number, 571-273-8300.

  
George C. Elliott  
Director, Technology Center 1600



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airtail No. EV 743885422 US, in a BOX addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: May 3, 2006

Signature:

*Lenzy Rogus*  
(Lenzy Rogus)

Patent

Docket No. 532212000623

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

**SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENT UNDER MPEP § 724.02**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.56 and MPEP § 724.02, the attention of the Patent and Trademark Office is hereby directed to the **SUBJECT TO PROTECTIVE ORDER** documents listed on the attached Form PTO/SB/08a/b. It is respectfully requested that the information be expressly considered during the prosecution of this application.

The document numbers 1-28 listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of each document that is **SUBJECT TO PROTECTIVE ORDER** listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope.

05/08/2006 BABRAHAI 00000025 031952 10617489

01 FC:1806 180.00 DA  
sd-312163

Document numbers 1-27 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, case number 02 CV 0046 B (JMA), currently on appeal at the United States Court of Appeals for the Federal Circuit.

Document number 28 is from *Scantibodies Laboratory, Inc. v. Immotopics, Inc.*, currently pending in the United States District Court for the Central District of California, Case No. CV04-8871 GPS (MANx).

Pursuant to MPEP § 2004.13, the patent owner points out the following:

- Deposition of Thomas Cantor, taken on August 27, 2003 (Document No. 3 in the present Form PTO/SB/08a/b) in which Mr. Cantor answered questions about the use of PTH (1-9) peptide (*See e.g.*, Document No. 3 at pages 78-80.)
- The Confidential Deposition of Tom Cantor, taken on July 11, 2005 (Document No. 28 in the present Form PTO/SB/08a/b) may contain information potentially relevant to the Declaration of Thomas L. Cantor pursuant to 37 C.F.R. § 1.132 as Exhibit A of the March 6, 2006 Amendment in Response to Non-Final Office Action in the present application.
- At page 00245, lines 12-13 of the Confidential Deposition of Tom Cantor, taken on July 11, 2005 (Document No. 28 in the present Form PTO/SB/08a/b), the sales figure of "Immotopics BioActive PTH ELISA assays" is redacted.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
  - ☐ A fee is required. A check in the amount of \_\_\_ is enclosed.
  - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of \_\_\_ is enclosed.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.)

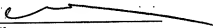
Applicant would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 532212000623.

Dated: May 3, 2006

Respectfully submitted,

By   
Peng Chen  
Registration No.: 43,543  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, California 92130-2040  
(858) 720-5117



ALTERNATIVE TO PTO/SB/08a/b (07-05)

|   |   |    |                          |                        |              |
|---|---|----|--------------------------|------------------------|--------------|
| Substitute for form 1449/PTO  |   |    | <b>Complete if Known</b> |                        |              |
| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br>(Use as many sheets as necessary) |   |    | Application Number       | 10/617,489             |              |
|   |   |    | Filing Date              | July 10, 2003          |              |
|   |   |    | First Named Inventor     | Thomas L. CANTOR       |              |
|   |   |    | Art Unit                 | 1641                   |              |
|   |   |    | Examiner Name            | C. Cheu                |              |
| Sheet   | 1 | of | 2                        | Attorney Docket Number | 532212000623 |

| U.S. PATENT DOCUMENTS |                          |  |                                   |  |   |
|-----------------------|--------------------------|--|-----------------------------------|--|---|
| Examiner<br>Initials* | Cite<br>No. <sup>1</sup> | Document Number                          | Publication<br>Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines, Where<br>Relevant Passages or Relevant<br>Figures Appear |
|                       |                          | Number-Kind Code <sup>2</sup> (if known) |                                   |  |   |

| FOREIGN PATENT DOCUMENTS |                          |   |                                   |  |   |                |
|--------------------------|--------------------------|---|-----------------------------------|--|---|----------------|
| Examiner<br>Initials*    | Cite<br>No. <sup>1</sup> | Foreign Patent Document   | Publication<br>Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines,<br>Where Relevant Passages or<br>Relevant Figures Appear | † <sup>6</sup> |
|                          |                          | Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known) |                                   |  |   |                |

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 501.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

| NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER |                          |   |  |  |                |
|---|--------------------------|---|--|--|----------------|
| Examiner<br>Initials*   | Cite<br>No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. |  |  | † <sup>2</sup> |
|   | 1.                       | Deposition of Claude D. Araud, taken on February 1, 2005  |  |  |                |
|   | 2.                       | Deposition of Gerald Bjorge, taken on January 27, 2005  |  |  |                |
|   | 3.                       | Deposition of Thomas Cantor, taken on August 27, 2003   |  |  |                |
|   | 4.                       | Deposition of Thomas Cantor (30(B)(6)), taken on September 11, 2003   |  |  |                |
|   | 5.                       | Deposition of Damon Cook, taken on June 16, 2003  |  |  |                |
|   | 6.                       | Deposition of Damon Cook (30(B)(6)), taken on September 12, 2003  |  |  |                |
|   | 7.                       | Deposition of Joseph O. Falkinham, taken on January 21, 2005  |  |  |                |
|   | 8.                       | Deposition of Wolf-Georg Forssmann, Ph.D., taken on August 25, 2003   |  |  |                |
|   | 9.                       | Deposition of Ping Gao, M.D., taken on June 18, 2003  |  |  |                |
|   | 10.                      | Deposition of Allen Garrett, taken on May 20, 2005  |  |  |                |
|   | 11.                      | Deposition of Thomas Godemeyer, taken on October 6, 2004  |  |  |                |
|   | 12.                      | Deposition of Mark Gray, taken on June 16, 2003   |  |  |                |
|   | 13.                      | Deposition of Dr. Richard Lerner, taken on January 13, 2005   |  |  |                |
|   | 14.                      | Deposition of Dr. Richard Lerner, taken on March 16, 2005   |  |  |                |
|   | 15.                      | Deposition of Markus Magerlein, Ph.D., taken on May 28, 2003  |  |  |                |
|   | 16.                      | Deposition of Markus Magerlein, Ph.D., taken on August 10, 2004   |  |  |                |
|   | 17.                      | Deposition of Michael Nordstrom (30(B)(6)), taken on September 17, 2003   |  |  |                |
|   | 18.                      | Deposition of K. Ramakrishnan, Ph.D., (30(B)(6)), taken on August 13, 2003  |  |  |                |
|   | 19.                      | Deposition of K. Ramakrishnan, Ph.D., (30(B)(6)), taken on September 3, 2003  |  |  |                |
|   | 20.                      | Deposition of Stephen Scheibel, taken August 8, 2003  |  |  |                |
|   | 21.                      | Deposition of Janet Sharp, taken on August 19, 2003   |  |  |                |
|   | 22.                      | Deposition of Randolph Wall, taken January 31, 2005   |  |  |                |
|   | 23.                      | Deposition of J. Stuart Woodhead, taken January 18, 2005  |  |  |                |
|   | 24.                      | Deposition of Zan Yang, Ph.D., taken on June 16, 2003   |  |  |                |

|                       |                    |
|-----------------------|--------------------|
| Examiner<br>Signature | Date<br>Considered |
|-----------------------|--------------------|

sd-312151

|  |   |                          |                  |                        |              |
|--|---|--------------------------|------------------|------------------------|--------------|
| Substitute for form 1449/PTO<br><br><b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br><i>(Use as many sheets as necessary)</i> |   | <b>Complete if Known</b> |                  |                        |              |
|  |   | Application Number       | 10/617,489       |                        |              |
|  |   | Filing Date              | July 10, 2003    |                        |              |
|  |   | First Named Inventor     | Thomas L. CANTOR |                        |              |
|  |   | Art Unit                 | 1641             |                        |              |
|  |   | Examiner Name            | C. Cheu          |                        |              |
| Sheet  | 2 | of                       | 2                | Attorney Docket Number | 532212000623 |

|     |   |  |
|-----|---|--|
| 25. | Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Its Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages Under Seal, filed January 27, 2006  |  |
| 26. | Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages, filed January 27, 2006  |  |
| 27. | [Proposed] Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Its Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages Under Seal, filed January 27, 2006, order signed Judge Brewster on January 31, 2006 |  |
| 28. | Confidential Deposition of Tom Cantor, taken on July 11, 2005   |  |

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a check mark here if English language Translation is attached.

|                       |  |                    |  |
|-----------------------|--|--------------------|--|
| Examiner<br>Signature |  | Date<br>Considered |  |
|-----------------------|--|--------------------|--|

sd-312151



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airmail No. EV 743885422 US, in a BOX addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: May 3, 2006

Signature:

*Lenay Rogers*  
(Lenay Rogers)

Patent

Docket No. 532212000623

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

**PETITION TO EXPUNGE INFORMATION  
UNDER MPEP § 724.06 AND 37 C.F.R. § 1.59**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to MPEP § 724.06 and 37 C.F.R. § 1.59(b), Applicant hereby petitions the Commissioner to have the 28 documents submitted in the above-identified application with the Supplemental Information Disclosure Statement on May 3, 2006 expunged upon allowance or abandonment of this application.

05/08/2006 BABRAHAI 00000025 031952 10617489

02 FC:1463 200.00 DA

sd-312180



Pursuant to MPEP § 724.05(a) and (b), Applicant believes expungement is appropriate for document numbers 1-27 listed on the attached Form PTO/SB/08a/b because they are **SUBJECT TO PROTECTIVE ORDER** in *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, case number 02 CV 0046 B (JMA), currently on appeal at the United States Court of Appeals for the Federal Circuit. These documents have not been otherwise made public.

Pursuant to MPEP § 724.05(a) and (b), Applicant believes expungement is appropriate for document number 28 listed on the attached Form PTO/SB/08a/b because it is **SUBJECT TO PROTECTIVE ORDER** in *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, currently pending in the United States District Court for the Central District of California, Case No. CV04-8871 GPS (MANx).

Please return the documents to the undersigned upon mailing of a Notice of Allowance or Abandonment of this application. Applicant acknowledges that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER** (document Nos. 1-28), Applicant will preserve the documents for the entire term of the patent in accordance with MPEP § 724.05 (c).

Pursuant to MPEP § 725.05 (d), this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

Pursuant to MPEP § 725.05 (e), the Commissioner is hereby authorized to charge the required fee under 37 C.F.R. § 1.17(g) for a petition under 37 C.F.R. § 1.59(b) to Deposit Account No. 03-1952 referencing docket no. 532212000623. Fee Transmittal (form PTO/SB/17p) is attached in duplicate.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 532212000623.

Dated: May 3, 2006

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543

MORRISON & FOERSTER LLP

12531 High Bluff Drive

Suite 100

San Diego, California 92130-2040

(858) 720-5117



5-4-06

FFW #

Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

|   |                        |                  |
|---|------------------------|------------------|
| <b>TRANSMITTAL FORM</b><br><br>(to be used for all correspondence after initial filing) | Application Number     | 10/617,489       |
|   | Filing Date            | July 10, 2003    |
|   | First Named Inventor   | Thomas L. CANTOR |
|   | Art Unit               | 1641             |
|   | Examiner Name          | C. Cheu          |
|   | Attorney Docket Number | 532212000623     |
| Total Number of Pages in This Submission  |                        | 16               |

**ENCLOSURES (Check all that apply)**

|  |   |  |
|--|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form (1 page plus duplicate)<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input checked="" type="checkbox"/> Information Disclosure Statement (4 pages)<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/ Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input checked="" type="checkbox"/> Petition to Expunge (3 pages)<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><div style="border: 1px solid black; width: 100px; height: 50px; margin: 5px auto;"></div> Landscape Table on CD<br><div style="border: 1px solid black; width: 100px; height: 20px; margin-top: 5px;"></div> Remarks | <input type="checkbox"/> After Allowance Communication to TC<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br>1. Petition Fee Transmittal Under 37 CFR 1.17(f), (g) & (h) (1 page plus duplicate)<br>2. PTO/SB/08a/b Form (2 pages plus duplicate)<br>3. References (28), placed in 28 separate envelopes, appropriately labeled<br>4. Return Receipt Postcard Return |
|--|---|--|

CUSTOMER NO. 25225

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|              |                         |                 |
|--------------|-------------------------|-----------------|
| Firm Name    | MORRISON & FOERSTER.LLP |                 |
| Signature    |                         |                 |
| Printed name | Peng Chen               |                 |
| Date         | May 3, 2006             | Reg. No. 43,543 |

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 743885422 US in one box addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: May 3, 2006

Signature:

(Lenay Rogus)



PTO/SB/17p (11-04)

Approved for use through 7/31/2007. OMB 0651-0031  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FEE**  
**Under 37 CFR 1.17(f), (g) & (h)**  
**TRANSMITTAL**

(Fees are subject to annual revision)

## Send completed form to:

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

|                        |                  |
|------------------------|------------------|
| Application Number     | 10/617,489       |
| Filing Date            | July 10, 2003    |
| First Named Inventor   | Thomas L. CANTOR |
| Art Unit               | 1641             |
| Examiner Name          | C. Cheu          |
| Attorney Docket Number | 532212000623     |

Enclosed is a petition filed under 37 CFR 1.59 that requires a processing fee (37 CFR 1.17(f)), (g), or (h)). Payment of \$ 200.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

## Payment of Fees (small entity amounts are NOT available for the petition fees).

☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 03-1952 :☒ Petition fee under 37 CFR 1.17(f), (g) or (h) ☒ Any deficiency of fees and credit of any overpayments

Enclose a duplicate copy of this form for fee processing.

☐ Check in the amount of \$ \_\_\_\_\_ is enclosed.☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

## Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

- § 1.53(e) – to record a filing date.
- § 1.57(a) – to record a filing date.
- § 1.182 – for decision on a question not specifically provided for.
- § 1.183 – to suspend the rules.
- § 1.378(e) – for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) – to record a filing date to an application under § 1.740 for extension of a patent term.

## Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

- § 1.12 – for access to an assignment record.
- § 1.14 – for access to an application.
- § 1.47 – for filing by other than all the inventors or a person not the inventor.
- § 1.59 – for expungement of information.
- § 1.103(a) – to suspend action in an application.
- § 1.136(b) – for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 – for review of refusal to publish a statutory invention registration.
- § 1.296 – to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 – for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) – for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.958 – for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 – for expedited handling of a foreign filing license.
- § 5.15 – for changing the scope of a license.
- § 5.25 – for retroactive license.

## Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) – to request documents in a form other than that provided in this part.
- § 1.84 – for accepting color drawings or photographs.
- § 1.91 – for entry of a model or exhibit.
- § 1.102(d) – to make an application special.
- § 1.138(c) – to expressly abandon an application to avoid publication.
- § 1.313 – to withdraw an application from issue.
- § 1.314 – to defer issuance of a patent.

\_\_\_\_\_  
Signature

Peng Chen

Typed or printed name

May 3, 2006

\_\_\_\_\_  
Date

43,543

Registration No., if applicable



PTO/ISB/17 (01-06)  
Approved for use through 7/31/2006. OMB 0651-0032  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

## FEE TRANSMITTAL For FY 2006

### Complete if Known

|   |  |   |
|---|--|---|
| <input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27 | <b>Application Number</b> 10/617,489         | <b>Filing Date</b> July 10, 2003        |
| <b>TOTAL AMOUNT OF PAYMENT</b> (\$ 180.00   | <b>First Named Inventor</b> Thomas L. CANTOR | <b>Examiner Name</b> C. Cheu            |
|   | <b>Art Unit</b> 1641                         | <b>Attorney Docket No.</b> 532212000623 |

### METHOD OF PAYMENT (check all that apply)

☐ Check    ☐ Credit Card    ☐ Money Order    ☐ None    ☐ Other (please identify): \_\_\_\_\_  
☒ Deposit Account    Deposit Account Number: 03-1952    Deposit Account Name: Morrison & Foerster LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below    ☐ Charge fee(s) indicated below, except for the filing fee  
☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17    ☒ Credit any overpayments

### FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

#### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES |                       | SEARCH FEES |                       | EXAMINATION FEES |                       | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
|                  | Fee (\$)    | Small Entity Fee (\$) | Fee (\$)    | Small Entity Fee (\$) | Fee (\$)         | Small Entity Fee (\$) |                |
| Utility          | 300         | 150                   | 500         | 250                   | 200              | 100                   |                |
| Design           | 200         | 100                   | 100         | 50                    | 130              | 65                    |                |
| Plant            | 200         | 100                   | 300         | 150                   | 160              | 80                    |                |
| Reissue          | 300         | 150                   | 500         | 250                   | 600              | 300                   |                |
| Provisional      | 200         | 100                   | 0           | 0                     | 0                | 0                     |                |

#### 2. EXCESS CLAIM FEES

| Fee Description                                    | Fee (\$) | Small Entity Fee (\$) |
|--|----------|-----------------------|
| Each claim over 20 (including Reissues)            | 50       | 25                    |
| Each independent claim over 3 (including Reissues) | 200      | 100                   |
| Multiple dependent claims                          | 360      | 180                   |

**Total Claims**    **Extra Claims**    **Fee (\$)**    **Fee Paid (\$)**  
 - 101    x    =    =

HP = highest number of total claims paid for, if greater than 20.

**Indep. Claims**    **Extra Claims**    **Fee (\$)**    **Fee Paid (\$)**  
 - 6    x    =    =

HP = highest number of independent claims paid for, if greater than 3.

#### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

**Total Sheets**    **Extra Sheets**    **Number of each additional 50 or fraction thereof**    **Fee (\$)**    **Fee Paid (\$)**  
 \_\_\_\_\_ - 100 = \_\_\_\_\_ /50 \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

#### 4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement    180.00

|                     |           |                                   |             |
|---------------------|-----------|-----------------------------------|-------------|
| <b>SUBMITTED BY</b> |           |                                   |             |
| Signature           |           | Registration No. (Attorney/Agent) | 43,543      |
| Name (Print/Type)   | Peng Chen | Date                              | May 2, 2006 |

## ARTIFACT SHEET

Enter artifact number below. Artifact number is application number + artifact type code (see list below) + sequential letter (A, B, C ...). The first artifact folder for an artifact type receives the letter A, the second B, etc..  
Examples: 59123456PA, 59123456PB, 59123456ZA, 59123456ZB

10617489 XC  
Indicate quantity of a single type of artifact received but not scanned. Create individual artifact folder/box and artifact number for each Artifact Type.

|                          |                                 |                          |
|--------------------------|---------------------------------|--------------------------|
| <input type="checkbox"/> | CD(s) containing:               | <input type="checkbox"/> |
|                          | computer program listing        |                          |
|                          | Doc Code: Computer              | Artifact Type Code: P    |
|                          | pages of specification          |                          |
|                          | and/or sequence listing         | <input type="checkbox"/> |
|                          | and/or table                    |                          |
|                          | Doc Code: Artifact              | Artifact Type Code: S    |
|                          | content unspecified or combined | <input type="checkbox"/> |
|                          | Doc Code: Artifact              | Artifact Type Code: U    |

☐ Stapled Set(s) Color Documents or B/W Photographs  
Doc Code: Artifact    Artifact Type Code: C

☐ Microfilm(s)  
Doc Code: Artifact    Artifact Type Code: F

☐ Video tape(s)  
Doc Code: Artifact    Artifact Type Code: V

☐ Model(s)  
Doc Code: Artifact    Artifact Type Code: M

☐ Bound Document(s)  
Doc Code: Artifact    Artifact Type Code: B

☒ <sup>sets</sup> Confidential Information Disclosure Statement or Other Documents  
marked Proprietary, Trade Secrets, Subject to Protective Order,  
Material Submitted under MPEP 724.02, etc.  
Doc Code: Artifact    Artifact Type Code X

☐ Other, description: \_\_\_\_\_  
Doc Code: Artifact    Artifact Type Code: Z

## UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

JUL 21 2006

MORRISON & FOERSTER LLP  
3811 VALLEY CENTRE DRIVE  
SUITE 500  
SAN DIEGO CA 92130-2332

In re Application of :  
Thomas L. Cantor et al :  
Serial No.: 10/617,489 : PETITION DECISION  
Filed: July 10, 2003 :  
Attorney Docket No.: 532212000623 :

This is a response to the petition under 37 CFR 1.59(b), filed May 3, 2006, to expunge information from the above identified application.

Petitioner requests that documents submitted May 3, 2006, as a third Proprietary Information Disclosure Statement be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

This is an examined application and a reply to the last Office action has been filed. The information provided will be reviewed by the examiner in due course. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application petition may be made for return of Proprietary Information Disclosure Statements. This application has not been allowed. Therefore, the information cannot be returned at this time.

The petition is **DISMISSED**. Applicants may resubmit the petition subsequent to a Notice of Allowability or *ex parte* Quayle action being mailed in the application. No additional petition fee will be required at that time.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at general Office facsimile number, 571-273-8300.

  
John L. LeGyader  
Director, Technology Center 1600

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airmail No. EV 958952245 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 1, 2008

Signature:

(Anthony Matson)

Patent

Docket No. 532212000623



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENT UNDER MPEP § 724.02

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the duty of disclosure in 37 C.F.R. § 1.56, Applicants hereby submit under MPEP § 724.02 the two documents listed on the attached Form PTO/SB/08a/b. The attention of the Patent and Trademark Office is hereby directed to these documents because they are **SUBJECT TO PROTECTIVE ORDER**. It is respectfully requested that the Examiner consider the information during the prosecution of this application.

The two documents listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent



and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of each document that is **SUBJECT TO PROTECTIVE ORDER** listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope.

The documents are from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, currently pending in the United States District Court for the Central District of California, Case No. CV 04-08871 MRP (MANx). Scantibodies Laboratory, Inc. is the owner of the present application. This litigation involves U.S. Patent No. 6,689,566. The present application is a Continuation-in-Part of U.S. Patent No. 6,743,590, which is a Continuation-in-Part of U.S. Patent No. 6,689,566. Immutopics' confidential information has been redacted from document number 2.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☒ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
  - ☐ A fee is required. A check in the amount of \_\_\_ is enclosed.
  - ☐ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of \_\_\_ is enclosed.

☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

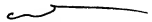
Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 532212000623.

Dated: February 1, 2008

Respectfully submitted,

By   
Peng Chen  
Registration No.: 43,543  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040  
(858) 720-5117



ALTERNATIVE TO PTO/SB/08A/B (04/07)

|   |   |                          |                  |                        |              |
|---|---|--------------------------|------------------|------------------------|--------------|
| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br>(Use as many sheets as necessary) |   | <b>Complete if Known</b> |                  |                        |              |
|   |   | Application Number       | 10/617,489       |                        |              |
|   |   | Filing Date              | July 10, 2003    |                        |              |
|   |   | First Named Inventor     | Thomas L. CANTOR |                        |              |
|   |   | Art Unit                 | 1641             |                        |              |
|   |   | Examiner Name            | C. Cheu          |                        |              |
| Sheet   | 1 | of                       | 1                | Attorney Docket Number | 532212000623 |

| NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER |                       |   |                |
|---|-----------------------|---|----------------|
| Examiner Initials   | Cite No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T <sup>2</sup> |
|   | 1.                    | Declaration of John W. Colford, M.D. in Opposition to Plaintiff's Motion for Partial Summary Judgment on Defendants' Counterclaim of Patent Invalidity Under 35 U.S.C. §§102 and 103, filed December 17, 2007   |                |
|   | 2.                    | Defendants and Counterclaimants' Memorandum of Points and Authorities in Opposition to Plaintiff's Motion for Partial Summary Judgment on Defendants' Counterclaim of Patent Invalidity Under 35 U.S.C. §§102 and 103, filed December 17, 2007                  |                |

<sup>1</sup>EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>2</sup>Applicant's unique citation designation number (optional). <sup>3</sup>Applicant is to place a check mark here if English language Translation is attached.

|                    |  |                 |  |
|--------------------|--|-----------------|--|
| Examiner Signature |  | Date Considered |  |
|--------------------|--|-----------------|--|

sd-409483

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 956952245 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 1, 2008

Signature: 

(Anthony Malson)

Patent

Docket No. 532212000623

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

PETITION TO EXPUNGE INFORMATION  
UNDER 37 C.F.R. § 1.59 (b)

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.59(b) and MPEP § 724, Applicants hereby petition the Commissioner to have the two documents submitted in the above-identified application with the Supplemental Information Disclosure Statement filed under MPEP § 724.02 on February 1, 2008 expunged upon allowance, issue, or abandonment of this application.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for document numbers 1 and 2 listed on the attached Form PTO/SB/08a/b because they are **SUBJECT TO PROTECTIVE ORDER**. The documents are from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, currently pending in the U.S.D.C. for the Central District of California, Case No. CV04-08871 MRP (MANx). These documents have not otherwise been made public.

sd-409497

02/04/2008 H05E01 0000017 031952 10617489

01 FC:1463 200.00 DR

Applicants acknowledge that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER** (document numbers 1 and 2 on the attached Form PTO/SB/08a/b), Applicants will preserve the documents for the entire term of the patent in accordance with MPEP § 724.05 (C). Please return the documents to the undersigned upon allowance, issue, or abandonment of this application.


Pursuant to MPEP § 725.05 (D), Applicants hereby state that this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

Pursuant to MPEP § 725.05 (E), the Commissioner is hereby authorized to charge the required fee under 37 C.F.R. § 1.17(g) for a petition under 37 C.F.R. § 1.59(b) to **Deposit Account No. 03-1952** referencing docket no. **532212000623**. Fee Transmittal (form PTO/SB/17p) is attached in duplicate.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **532212000623**.

Dated: February 1, 2008

Respectfully submitted,

By   
Peng Chen  
Registration No.: 43,543  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040  
(858)720-5117



02-04-08

BAC/TFW

Approved for use through 01/31/2008. OMB 0651-0031  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

|   |    |                        |                  |
|---|----|------------------------|------------------|
| <b>TRANSMITTAL<br/>FORM</b><br><br>(to be used for all correspondence after initial filing) |    | Application Number     | 10/617,489       |
|   |    | Filing Date            | July 10, 2003    |
|   |    | First Named Inventor   | Thomas L. CANTOR |
|   |    | Art Unit               | 1641             |
|   |    | Examiner Name          | C. Cheu          |
| Total Number of Pages in This Submission  | 10 | Attorney Docket Number | 532212000623     |

**ENCLOSURES (Check all that apply)**

|   |  |   |
|---|--|---|
| <input type="checkbox"/> Fee Transmittal Form   | <input type="checkbox"/> Drawing(s)  | <input type="checkbox"/> After Allowance Communication to TC                            |
| <input type="checkbox"/> Fee Attached   | <input type="checkbox"/> Licensing-related Papers  | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences     |
| <input type="checkbox"/> Amendment/Reply  | <input checked="" type="checkbox"/> Petition - Petition to Expunge Information (2 pages) | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final  | <input type="checkbox"/> Petition to Convert to a Provisional Application                | <input type="checkbox"/> Proprietary Information  |
| <input type="checkbox"/> Affidavits/declaration(s)  | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  | <input type="checkbox"/> Status Letter  |
| <input type="checkbox"/> Extension of Time Request  | <input type="checkbox"/> Terminal Disclaimer   | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):         |
| <input type="checkbox"/> Express Abandonment Request  | <input type="checkbox"/> Request for Refund  | Form PTO/SB/08A/B (1 page + duplicate)  |
| <input checked="" type="checkbox"/> Information Disclosure Statement - Supplemental (3 pages) | <input type="checkbox"/> CD, Number of CD(s) _____                                       | Petition Fee (1 page + duplicate)   |
| <input type="checkbox"/> Certified Copy of Priority Document(s)                               | <input type="checkbox"/> Landscape Table on CD   | References (2)  |
| <input type="checkbox"/> Reply to Missing Parts/Incomplete Application                        |  | Return Receipt Postcard   |
| <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53                     |  |   |

Remarks

Customer No. 25225

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|              |                         |          |        |
|--------------|-------------------------|----------|--------|
| Firm Name    | MORRISON & FOERSTER LLP |          |        |
| Signature    |                         |          |        |
| Printed name | Peng Chen               |          |        |
| Date         | February 1, 2008        | Reg. No. | 43,543 |

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 958952245 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 1, 2008

Signature:

(Anthony Matson)



Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FEE**  
**Under 37 CFR 1.17(f), (g) & (h)**  
**TRANSMITTAL**

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

|                        |                  |
|------------------------|------------------|
| Application Number     | 10/617,489       |
| Filing Date            | July 10, 2003    |
| First Named Inventor   | Thomas L. CANTOR |
| Art Unit               | 1641             |
| Examiner Name          | C. Cheu          |
| Attorney Docket Number | 532212000623     |

Enclosed is a petition filed under 37 CFR 1.59 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 200.00 is enclosed.  
This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

**Payment of Fees** (small event amounts are NOT available for the petition fees).

- ☐ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 03-1952 :  
☒ petition fee under 37 CFR 1.17(f), (g) or (h) ☐ any deficiency of fees and credit of any overpayments  
Enclose a duplicate copy of this form for fee processing.
- ☐ Check in the amount of \$ \_\_\_\_\_ is enclosed.
- ☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

- § 1.36(a) – for revocation of a power of attorney by fewer than all applicants
- § 1.53(e) – to accord a filing date.
- § 1.57(a) – to accord a filing date.
- § 1.162 – for decision on a question not specifically provided for.
- § 1.163 – to suspend the rules.
- § 1.376(e) – for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) – to accord a filing date to an application under § 1.740 for extension of a patent term.

**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

For petitions filed under:

- § 1.12 – for access to an assignment record.
- § 1.14 – for access to an application.
- § 1.47 – for filing by other than all the inventors or a person not the inventor.
- § 1.69 – for expungement of information.
- § 1.103(a) – to suspend action in an application.
- § 1.136(b) – for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.296 – for review of refusal to publish a statutory invention registration.
- § 1.298 – to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 – for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.559(c) – for patent owner requests for extension of time in ex parte reexamination proceedings.
- § 1.958 – for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 5.12 – for expedited handling of a foreign filing license.
- § 5.15 – for changing the scope of a license.
- § 5.25 – for retroactive license.

**Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

- § 1.15(g) – to request documents in a form other than that provided in this part.
- § 1.84 – for accepting color drawings or photographs.
- § 1.91 – for entry of a model or exhibit.
- § 1.102(d) – to make an application special.
- § 1.135(c) – to expressly abandon an application to avoid publication.
- § 1.213 – to withdraw an application from issue.
- § 1.314 – to defer issuance of a patent.

\_\_\_\_\_  
Signature  
Peng Chen  
\_\_\_\_\_  
Typed or printed name

\_\_\_\_\_  
Date  
February 1, 2008  
\_\_\_\_\_  
43,543  
\_\_\_\_\_  
Registration No., if applicable

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbtl No. EV 956552245 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 1, 2008

Signature: \_\_\_\_\_

(Anthony Matsen)



UNITED STATES PATENT AND TRADEMARK OFFICE

FEB 08 2008

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO CA 92130-2040

In re Application of

Cantor et al.

Serial No.: 10/617,489

Filed: July 10, 2003

Attorney Docket No.: 532212000623

:  
:  
: PETITION DECISION  
:  
:

This is a response to the petition under 37 CFR 1.59(b), filed February 1, 2008, to expunge information from the above identified application.

Petitioner requests that the supplemental IDS filed February 1, 2008 having two documents set forth therein be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The \$200.00 petition fee set forth in 37 CFR 1.17(h) has been paid.

Applicants state the proprietary material submitted on Form PTO 1449 is "subject to protective order". Applicants also state that this information is confidential and should be expunged after examiner consideration if it is found not to be important in deciding whether to allow the application.

This is currently an examined application. The newly submitted IDS has not been reviewed and the petition cannot be granted at this time. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application, petition may be made for return of Proprietary information. However, the information cannot be expunged at this time.



The petition is **DISMISSED**. Applicant may resubmit the petition subsequent to a Notice of Allowability or *ex parte* Quayle action being mailed in the application. No additional petition fee will be required at that time.

Should there be any questions with respect to this decision, please contact Marianne C. Seidel, by mail addressed to: Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0584 or by facsimile transmission at general Office facsimile number, 703-872-9306.

A handwritten signature in black ink, appearing to read "M. C. Seidel". The signature is fluid and cursive, with the first name "Marianne" and last name "Seidel" clearly distinguishable.

Marianne C. Seidel  
Quality Assurance Specialist/Program Manager  
Technology Center 1600